

ESTTA Tracking number: **ESTTA451244**Filing date: **01/13/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Y.P. GOLAN TRADE LTD		
Entity	Limited Company	Citizenship	Israel
Address	Hasira 29 Rishon Le Zion, 3977 ISRAEL		
Attorney information	Michael N. Cohen Cohen IP Law Group, P.C. 9025 Wilshire Blvd., Suite 301 Beverly Hills, CA 90211 UNITED STATES michael@patentlawip.com Phone:310-288-4500		

Registrations Subject to Cancellation

Registration No	3478807	Registration date	08/05/2008
Registrant	MOROCCANOIL, INC. 16311 Ventura Blvd Suite 1200 Los Angeles, CA 91436 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 2007/01/01 First Use In Commerce: 2007/01/01
All goods and services in the class are cancelled, namely: Hair conditioners, namely, curl creams, hydrating styling creams, intense moisturizing masques, and styling and finishing oils

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Genericness	Trademark Act section 23		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)		
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)		
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)		
Registration No	3684910	Registration date	09/22/2009
Registrant	MOROCCANOIL, INC. 16311 Ventura Blvd Suite 1200 Los Angeles, CA 91436 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 2007/03/11 First Use In Commerce: 2007/03/11
All goods and services in the class are cancelled, namely: Hair conditioners, namely, curl creams, hydrating style creams, intense moisturizing masques, and styling and finishing oils

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
Genericness		Trademark Act section 23	
The mark is merely descriptive		Trademark Act section 2(e)(1)	
The mark is deceptively misdescriptive		Trademark Act section 2(e)(1)	
The mark is primarily geographically descriptive		Trademark Act section 2(e)(2)	
The mark is primarily geographically deceptively misdescriptive		Trademark Act section 2(e)(3)	
Registration No	3684909	Registration date	09/22/2009
Registrant	MOROCCANOIL, INC. 16311 Ventura Blvd Suite 1200 Los Angeles, CA 91436 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 2007/03/11 First Use In Commerce: 2007/03/11
All goods and services in the class are cancelled, namely: Hair conditioners, namely, curl creams, hydrating style creams, intense moisturizing masques, and styling and finishing oils

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
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The mark is primarily geographically descriptive		Trademark Act section 2(e)(2)	
The mark is primarily geographically deceptively misdescriptive		Trademark Act section 2(e)(3)	

Related Proceedings	91197795
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Attachments	Cancellation Petition.pdf (13 pages)(109965 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael N. Cohen/
Name	Michael N. Cohen
Date	01/13/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Y.P. GOLAN TRADE LTD.)	
)	
Petitioner,)	
)	
vs -)	Cancellation No. _____
)	[Registration Nos. 3,478,807;
MOROCCANOIL, INC.)	3,684,910; 3,684,909]
)	
Respondent)	
_____)	

PETITION FOR CANCELLATION

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Petitioner, Y.P. GOLAN TRADE LTD., a foreign Israeli limited company, (hereinafter "Petitioner") believes that it will be damaged by three registrations to MOROCCANOIL, INC. (the "Respondent") of the marks (1) MOROCCANOIL (the "Subject Marks") shown in Registration Nos. 3,478,807, filed on March 5, 2007 and published on May 20, 2008; (2)



M MOROCCANOIL shown in Registration Nos. 3,684,909, filed on December 26, 2007 and published on December 2, 2008; and (3) M MOROCCANOIL



shown in Registration No. 3,684,910, filed on December 26, 2007 and published on December 2, 2008, (collectively the "Subject Marks"). Petitioner, by its attorneys Cohen I.P. Law Group, P.C., seeks cancellation of the registration of the Subject Marks, and as grounds for its petition alleges as follows:

1. Registrant owns the Registration Nos. 3,478,807, 3,684,910, 3,684,909 for the above referenced alleged marks for "MOROCCAN OIL" and "M MOROCCANOIL" registered in connection with "hair conditioners" and "finishing oils" in International Class 003.
2. Petitioner, is the owner of the mark "Royal Moroccan" currently pending U.S. Trademark Serial No. 85/023269 for Royal Moroccan in International Class 003 for non-medicated hair treatment preparations for cosmetic purposes made of serum for use in professional hair salons.
3. On or around March 8, 2011, Registrant filed a declaratory relief action against Petitioner in the United States District Court, Central District of California, under case no. 11-cv-01974-JSL(JEMx) requesting an adjudication that the mark Royal Moroccan is likely to infringe Registrant's mark for MOROCCAN OIL.
4. The Subject Marks were issued by the U.S. Patent and Trademark Office, for the hair conditioners, namely, curl creams, hydrating styling creams, intense moisturizing masques, and styling and finishing oils in International Class 003.
5. Petitioner is being damaged and will continued to be damaged by the Registration because unless canceled, Registrant is and will continue to use the Registration to

assert trademark-related claims, despite the lack of protectability of Registrant's trademark under the Registration due to its lack of distinctiveness.

THE MARK "MOROCCAN OIL" IS GENERIC

6. Petitioner restates, realleges and incorporates by reference the allegations set forth in paragraphs 1-5 above.
7. The origin of the name MOROCCAN OIL, stems from the word Argan, which is one of the ingredients of Respondent's products. The generic term for this argan nut oil is "Moroccan oil" the key ingredient in Registrant's products and the basis for the Registration for MOROCCAN OIL.
8. Argan tree, a tree native to Morocco, and produces the Argan Nut, the oil of which has been used in beauty and hair care products for generations. All uses of the terms Argan Oil, Argan Nut Oil, Moroccan Argan Oil, Moroccan Nut Oil, Moroccan Oil, and the like are generic as any reference of Moroccan Oil has been generally known to contain Argan Nut.
9. Argan oil is referred to as Moroccan oil, due to the fact it originates from Morocco, which is also considered to be the leading manufacturer in terms of quality.
10. Registrant's mark should be cancelled as its use of MOROCCAN OIL is generic and not unique to Registrant's products, and simply defines the characteristics of a product.
11. To allow the continuation of a monopoly on a generic term would be contrary to the public interest in promoting competition.

THE MARK “MOROCCAN OIL” IS MERELY DESCRIPTIVE

12. Petitioner restates, realleges and incorporates by reference the allegations set forth in paragraphs 1-11 above.
13. The term “Moroccan Oil” is highly descriptive of Registrant’s hair care products, the key ingredient of which is Moroccan Oil.
14. Consumers do not associate the mark MOROCCAN OIL with a single source, and the mark has no secondary meaning.
15. “Moroccan oil” has been a descriptive term used in connection with the argan nut oil and beauty and hair care goods since well prior to Registrant’s Application for Federal Registration.
16. Petitioner will suffer irreparable harm and financial damage by not being able to use the generically descriptive terms "Moroccan Oil" in its descriptive sense when advertising its mark ROYAL MOROCCAN and/or associated products.

**THE MARK “MOROCCAN OIL” IS PRIMARILY GEOGRAPHICALLY
DESCRIPTIVE**

17. Petitioner restates, realleges and incorporates by reference the allegations set forth in paragraphs 1-16 above.
18. Registrant's mark for MOROCCAN OIL should be cancelled as the mark's primary significance is a generally known geographic location, namely Moroccan.
19. The term “Moroccan oil” is highly descriptive of the geographic region in which the key ingredient of Registrant’s hair care products are found; i.e., Morocco.

20. The relevant public would be likely to associated Registrant's hair oil to the location of Morocco, and would believe that Registrant's goods originate from Morocco.

21. The Registration for MOROCCAN OIL which is primarily geographically descriptive and lacking in secondary meaning, should not exist in view of 15 U.S.C. § 1052(e).

THE MARK “MOROCCAN OIL” IS DECEPTIVELY MISDESCRIPTIVE

22. Moroccan oil is a highly desirable ingredient in hair care products to a certain segment of the purchasing public. The term “Moroccan oil” is highly deceptively misdescriptive when used or associated with Registrant’s products because Registrant’s customers will likely believe that the primary ingredient of the goods is Moroccan oil, when in fact the content of the following ingredients exceed the content of Moroccan oil: cyclopentasiloxane, dimethicone, cyclomethicone, butylphenyl, and methylpropional. The term “Moroccan oil” gives a false indication of the primary ingredients contained in Registrant’s products to that segment of the purchasing public which may be interested in the ingredients and the concentration of Moroccan oil, and the mark is likely to deceive them and serve as a material factor for the purchase of Registrant’s products.

23. Moroccan oil from Morocco is a highly desirable ingredient in hair care products to a certain segment of the purchasing public. The term “Moroccan oil” is highly deceptively misdescriptive because Registrant’ customers will likely believe that the goods are made in Morocco, when in fact the goods are made in Israel. The term “Moroccan oil” gives a false indication of geographical origin to that

- segment of the purchasing public which may be interested in the country of origin, and the mark is likely to deceive them and serve as a material factor for the purchase of Registrant's products.
24. Consumers do not associate the mark MOROCCAN OIL with a single source and the mark has no secondary meaning.
25. To allow the continuation of a monopoly on a deceptively misdescriptive term would be contrary to the public interest in consumer protection and fair competition.
26. The Registration for MOROCCAN OIL which is deceptively misdescriptive, should not exist in view of 15 U.S.C. § 1052(e).

**THE MARK "MOROCCAN OIL" IS GEOGRAPHICALLY
MISDESCRIPTIVE**

27. Moroccan oil from Morocco is highly desirable ingredient in hair care products to a certain segment of the purchasing public. The term "Moroccan oil" is highly primarily geographically deceptively misdescriptive because Registrant's customers will likely believe that the goods are made in Morocco, when in fact the goods are made in Israel. The term "Moroccan oil" gives a false indication of geographical origin to that segment of the purchasing public which may be interested in the country of origin and the mark is likely to deceive them and serve as a material factor for the purchase of Registrant's products.
28. Consumers to do not associate the mark MOROCCAN OIL with a single source, and the mark has no secondary meaning.

29. To allow the continuation of a monopoly on a primarily geographically deceptively misdescriptive term would be contrary to the public interest in consumer protection and fair competition.
30. The Registration for MOROCCAN OIL, which is primarily geographically deceptively misdescriptive, should not exist in view of 15 U.S.C. § 1052(e).

FRAUD

31. Upon information and belief, Respondent's registration for the Subject Marks is void *ab initio* for fraud upon the Trademark Office, in that Respondent's claim of acquired distinctiveness is false.
32. On June 19, 2007, the Respondent received an office action rejecting the application for MOROCCAN OIL, now Reg. No. 3,478,807, on the basis that it is merely descriptive.
33. On December 20, 2007, in response to the Office Action, Respondent provided a declaration in the Reg. No. 3,478,807 from Ofer Tal representing to the PTO that the mark for MOROCCAN OIL has achieved "acquired distinctiveness" although the application for MOROCCAN OIL was filed on an "1B intent to use" basis. Respondent made this representation to induce the PTO to issue a registration.
34. On or about December 19, 2007, Respondent misrepresented to the USPTO that Respondent own the manufacturing and distribution of the Moroccanoil products when in fact they did not. In particular, on or about December 19, 2007 Respondent informed the USPTO via a sworn declaration under § 18 U.S.C. 1001 that Respondent has been manufacturing and have used the mark "Moroccanoil" in commerce for over a year prior to December 19, 2007 in the United States

when in fact Respondent knew someone other than Respondent by was actually manufacturing and distributing the product and only in Israel.

35. Respondent misrepresented to the USPTO that they distributed Moroccanoil product throughout the United States and the world when in fact they had not. In particular, on or about December 20, 2007, Ofer Tal signed a Declaration acknowledging that the Declaration was made under § 18 U.S.C. 1001 and falsely stating that Ofer Tal, owned Moroccanoil, Inc., a Florida corporation when in fact he didn't according to the Secretary of State of Florida, in December, 2007, as no corporate entity existed bearing the word "Moroccanoil" in its name.
36. Respondent misrepresented to the USPTO and other judicial tribunals under oath that they had invented the concept of applying Argan Oil to hair products when in fact they did not. In particular, on or about December 20, 2007, Ofer Tal, signed a sworn declaration acknowledging that the Declaration made under § 18 U.S.C. 1001 and falsely stated in this declaration that his wholly owned company(s) Moroccanoil, Inc. was the first to introduce hair care products containing Argan Oil when in fact Argan Oil has been a descriptive term used in connection with the Argan Nut Oil in cuisine, beauty and hair care goods since well prior to Respondent's application for federal registration. Respondent did not invent Moroccan Argan Oil, nor its use as a beauty/hair care product. More, Ofer Tal and Respondent expressly knew that Masoret Midkademmet had been using Moroccan Oil (Argan Oil) in beauty/hair care products for some years prior to Respondent's application to the USPTO.

37. Respondent misrepresented to the USPTO that they licensed a company by the name MPL, when in fact they did not. In particular, on or about December 20, 2007, Ofer Tal signed a declaration acknowledging that the declaration made under § 18 U.S.C. 1001 was false, in that MPL was Respondents' licensee when in fact Respondent declared on the same sworn declaration that M.P.L. was Respondent's licensor.
38. Respondent misrepresented to USPTO that they licensed a company by the name MPL which was doing business under the name Praxis, when in fact they did not. In particular, on or about December 20, 2007 Ofer Tal signed a Declaration acknowledging that the Declaration is made under 18 U.S.C. 1001 falsely representing that MPL was Respondent's Licensee which was doing business under the name Praxis when in fact there was no entity by the name Praxis licensed in the nation of Israel to conduct Respondent's business as such; Respondent's made these false Statements so Defendants could falsely secure from USPTO the issuance of a Trademark based on the product alleged acquiescence of a "Secondary Meaning".
39. Respondent falsely stated to USPTO that Haim Lampert had the legal authority to legally empower Respondent to apply for a US Trademark with USPTO for the Moroccanoil term-- when in fact he did not. In particular, on or about December 20, 2007 Ofer Tal signed a Declaration and falsely declared thereupon in Paragraph 2 that MPL was Respondent's Licensor with the appropriate legal rights to license Respondent to apply for a Trademark for the term "Moroccanoil" when in fact Haim Lampert wasn't the Trademark and/or name legal title owner.

Respondent declared within the same Sworn Declaration, Paragraph 8 that M.P.L. was in fact Respondent's Licensee when in fact M.P.L. was not; M.P.L. could not have been legally or factually the licensor and/or the licensee of Respondent at the same time. Respondent made these fraudulent statements knowing at that time that they were false, or with such a wanton and reckless disregard for the truth as to amount to an affirmative defalcation of a duty of candor Respondent owed to USPTO and to the general public, of which Petitioner is a member. Respondent knowingly made such false representations in order to fraudulently secure from USPTO the issuance of a Trademark based on the product alleged acquiescence of a "Secondary Meaning". MPL via its authorized director Haim Lampert wrote an illegal authorization letter dated August 16, 2006, which was attached to Respondent Ofer Tal's Sworn Declaration as Declaration Exhibit "A" authorizing Ofer Tal the registration of Respondent's Trademark.

40. Respondent received similar office actions in the applications for M MOROCCANOIL, now Reg. No. 3,684,909, and M MOROCCANOIL, now Reg. No. 3,684,910, on the basis that the term "MOROCCAN OIL" must be disclaimed and is merely descriptive as it described ingredients in the goods.
41. In response to the disclaimer requirements in both applications, Respondent responded stating that "MoroccanOil, Inc. owns the trademark registration number 3,478,807, consisting of the standard character mark "MOROCCANOIL," which was registered pursuant to Section 2(f)."
42. Upon information and belief, Respondent's registration for the Subject Marks are void *ab initio* for fraud upon the Trademark Office, in that Respondent knew that

its use of the term MOROCCAN OIL was merely descriptiveness and was without any acquired distinctiveness.

43. Upon information and belief, at the time of filing its application, Respondent did not achieve acquired distinctiveness of the mark MOROCCAN OIL, in violation of Section 1(a) of the Trademark Act, and therefore has committed fraud on the Trademark Office.
44. Upon information and belief, the Respondent knew that its representations were false, and knowingly made the material misrepresentations to the PTO in its effort to procure a registration.
45. The PTO relied on the representation in issuing Registration Nos. 3,478,807, 3,684,909, and 3,684,910.
46. Upon information and belief, Respondent intended to deceive the USPTO in that he knowingly made inaccurate or misleading statements in the applications for the Subject Marks in its effort to procure a registration.

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WHEREFORE, Petitioner requests that its Petition for Cancellation be granted and that Registration Nos. 3,478,807, 3,684,909, and 3,684,910 be stricken from the Principal Register.

Respectfully submitted,

COHEN IP LAW GROUP, P.C.

Dated: January 13, 2012

By: /Michael N. Cohen/
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Attorneys for Petitioner
Y.P. GOLAN TRADE LTD.

CERTIFICATE OF SERVICE

I hereby certify that a copy of this Petition for Cancellation is being served on January 13, 2012 by certified mail to Registrant at 22287 Mulholland Highway, Calabasas, California 91302, and to its attorney William C. Conkle, Conkle Kremer & Engel, 3130 Wilshire Blvd., Ste 500, Santa Monica, California 90403.

/Jake Rogers/

Jake Rogers